

TFW 2157

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No.: 10/090,893
Filed: March 5, 2002
Inventors:
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Title: Synchronization Of Documents
Between A Server And Small
Devices



§ Examiner: Jacobs, Lashonda T.
§ Group/Art Unit: 2157
§ Atty. Dkt. No: 5681-10500
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I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to Commissioner for Patents, Alexandria, VA 22313-1450, on the date indicated below.

Robert C. Kowert

Name of Registered Representative

June 14, 2006

Signature

Date

PETITION UNDER 37 CFR 1.144

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This paper is submitted as a petition under 37 CFR 1.144 from the restriction requirement made final in the Office Action dated January 17, 2006.

In the Office Action dated September 23, 2005, the Examiner presented a restriction requirement requiring election of one of the following two inventions as defined by the Examiner:

I. Claims 1-11, 21-26, 28-29, 30-35 and 37-38, drawn to a system, method, and an article of manufacture comprising a server comprising a document in a format supported by the server, wherein the document is available to one or more devices via a network; a small device configured to couple to the server, ... etc. classified in class 715, subclass 500.

II. Claims 12-20 drawn to a server comprising a processor; a memory operable to store program instructions wherein the program instructions are executable by the processor [to] generate a small device document in a format supported by one or more small devices from an original document, ... etc. classified in class 709, subclass 203.

In the Response filed October 26, 2005, Applicants elected Invention I (as defined by the Examiner) **with traverse** and presented reasons for traversal. In the Office Action dated January 17, 2006, the Examiner effectively made the restriction requirement final by only examining the elected claims. Applicants hereby petition for withdrawal of the restriction requirement for at least the following reasons.

In the Office Action dated September 23, 2005, the Examiner contends that “Inventions I and II are related as subcombinations disclosed as usable together in a single combination.” However, Inventions I and II are *not disclosed* in Applicants’ disclosure as *separate subcombinations* usable together in a single combination. For example, the claims of Invention I (as defined by the Examiner) and Invention II (as defined by the Examiner) each recite similar servers. According to the Examiner’s reasoning, Applicants’ disclosure would have to describe the server of Invention I as being used in a single combination together with the server of Invention II. However, the server recited in both claim 1 (Invention I) and claim 12 (Invention II) corresponds to embodiments of the same server described in the specification (e.g. server 102 in FIGs. 1A, 1B, 2, 7A, 7B, 8A and 8B), not separate subcombinations. Therefore, the Examiner’s characterization of claims 1 and 12 being limited to separate subcombinations disclosed in the specification as usable together in a single combination is inaccurate. Accordingly, the Examiner’s rationale for requiring restriction is flawed.

Furthermore, according to M.P.E.P. 806.05(d) subcombinations are usually restrictable when the subcombinations do not overlap in scope and are not obvious variants. Since both Invention I and Invention II include a similar server, there is an overlap in scope between Inventions I and Invention II. Thus, Inventions I and II are not separate restrictable subcombinations according to M.P.E.P. 806.05(d). For example, an entity could provide a server that met the limitations of the server of claim 1 (Invention I) and the server of claim 12 (Invention II) and use that server with a small device as recited in claim 1. Such an entity would infringe both claim 1 (Invention I) and claim 12 (Invention II). Since there is some overlap between Invention I and Invention II, according to M.P.E.P. 806.05(d) restriction cannot be required as subcombinations

useable together in a disclosed combination. Thus, the Examiner clearly has not stated a proper restriction requirement.

Furthermore, to state a proper restriction requirement for subcombinations usable together in a single combination, the Examiner “must show, by way of example, that one of the subcombinations has utility other than in the disclosed combination.” The burden is on the Examiner to provide a proper example. M.P.E.P. 806.05(d). The example given by the Examiner is that “invention I has separate utility such as drawn to a system, method, and article of manufacture comprising a server comprising a document in a format supported by the server, wherein the document is available to one or more devices via a network; a small device configured to couple to the server,...etc (as set forth in invention II).” The Examiner has merely repeated her definition of Invention I. The Examiner has not provided an example of a utility for one of the subcombinations other than in the disclosed combination. In fact, in stating a separate utility for Invention I, the Examiner concludes by stating “as set forth in invention II”. Thus, on its face, the example of a utility set forth by the Examiner would seem to apply to both Invention I and Invention II. Applicant is not asserting that a separate utility is not possible; however, the Examiner has clearly failed to provide an example of a separate utility as required by M.P.E.P. 806.05(d). The “burden is on the Examiner to provide a proper example” of such utility. M.P.E.P. 806.05(d). The Examiner has clearly not met this burden. Thus, the restriction requirement is improper.

Another shortcoming of the Examiner’s restriction requirement is in regard to the requirement of M.P.E.P. § 808 for the Examiner to also show “reasons why there would be a serious burden on the examiner if restriction is not required”. **The Examiner has failed to make any statement or provide any reasons as to why there would be a serious burden if restriction were not required.** Therefore, the Examiner did not state a proper restriction requirement.

Perhaps the Examiner intended to rely on a different classification to show a separate status in the art. However, any such reliance by the Examiner on a different

classification would be misplaced because the purported classifications are not separate for the two claim groups.

For example, the Examiner states that Invention I is classified as class 715, subclass 500 and that Invention II is classified as class 709, subclass 203. However, these classifications could both be applied to all of the claims, and are thus not separate for the two groups. According to the Manual of Classification, the definition of class 715, subclass 500 is for subject matter in which humanly perceptible elements of electronic information (i.e., text or graphics) are gathered, associated, created, formatted, edited, prepared, or otherwise processed in forming a unified collection of such information storable as a distinct entity. This classification could also apply to the claims of Invention I. Neither the claims of Invention I nor the claims of Invention II exclude gathering, associating, creating, formatting, editing, preparing, or other processing humanly perceptible elements of electronic information in a unified collection of such information storable as a distinct entity. Thus, class 715, subclass 500 is not a truly separate classification for the claims of groups I and II.

The definition for class 709, subclass 203 is for subject matter in which at least one local computer provides a user interface and performs local data processing to interact with at least one remote computer which implements data processing (e.g., data management, data sharing) within a generic time-sharing environment in response to the local computer to transfer data between the local computer and the remote computer. This classification could equally be applied to Invention I as the claims of Invention I do not exclude a local computer providing user interface and performing local data processing to interact with at least one remote computer that implements data processing. Thus, class 709, subclass 203 is not a truly separate classification for the claims of groups I and II.

As shown above, the Examiner has not established that separate classifications apply to the claim groups. Since the purported classifications could actually relate to all of the claims, the Examiner clearly cannot rely upon these classifications to establish “a

serious burden on the examiner if restriction is not required.” *See* M.P.E.P. § 808. Since the Examiner’s has failed to establish a “serious burden on the examiner if restriction is not required”, Applicants’ assert that the Examiner has not established all of the necessary elements of a *prima facie* restriction requirement as required by M.P.E.P. § 808.

In summary, the Examiner’s restriction requirement is improper for numerous reasons. First, the Examiner’s categorization of the claims of Group I and Group II being related as separate subcombinations usable together in a single combination is clearly inaccurate. Second, the Examiner has failed to meet her burden to show that one of the alleged subcombinations has utility other than in the disclosed combination. And third, the Examiner has not provided any valid reasons why there would be a serious burden on the Examiner if restriction is not required. Therefore, Applicants assert that the Examiner has not established any of the necessary elements of a *prima facie* restriction requirement. Accordingly, the Examiner’s restriction requirement must be withdrawn.

CONCLUSION

In light of the above remarks, Applicants request that the restriction requirement be withdrawn.

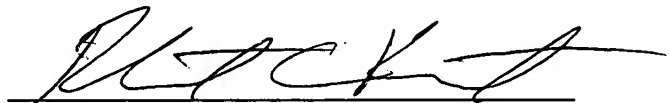
If any extension of time (under 37 C.F.R. § 1.136) is necessary to prevent the above referenced application from becoming abandoned, Applicants hereby petition for such extension. If any fees are due, the Commissioner is authorized to charge said fees to Meyertons, Hood, Kivlin, Kowert & Goetzel PC Deposit Account No. 50-1505/5681-10500/RCK.

Also enclosed herewith are the following items:

☒ Return Receipt Postcard

☐ Other:

Respectfully submitted,



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